

Amendments to the drawings:

Replacement sheets containing Figs. 1-4 are attached hereto. Figs. 1-4 have been amended to add the legend -- Prior Art --.

REMARKS

The present amendment is submitted in response to the Office Action dated July 22, 2005, which set a three-month period for response, making this amendment due by October 22, 2005.

Claims 1-21 are pending in this application.

In the Office Action, the drawings were objected to for an informality. Claims 1, 4, 5, 13-17, 20 and 21 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,414,260 to Vogt. Claims 1, 4-9, and 15-21 were rejected under 35 U.S.C. 102(b) or alternatively 35 U.S.C. 102(a) as being anticipated by Applicant Admitted Prior Art (AAPA). Claims 2, 3, 11, and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over either Vogt or AAPA in view of U.S. Patent No. 5,920,014 to Waschkies. Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over either Vogt or AAPA in view of U.S. Patent No. 6,297,467 to Maev et al.

Turning first to the objection to the drawings, Figs. 1-4 have been amended to add the legend -- Prior Art -- as suggested by the Examiner.

The Applicants respectfully disagree with the substantive rejections of claims 1-21.

The cited patent to Vogt does not disclose a connecting element comprising a sensor. Rather, Vogt discloses a shaft 8 (i.e., the connecting element) located between the welding electrode cap 16 and the electrode holder 6. This electrode holder 6 is comparable to the electrode arm of the invention.

The sensor is located inside this electrode holder 6 (the electrode arm of the present invention) and not inside the shaft 8 (that is, the connecting element). In this connection, please see column 5, lines 3-7. The cited text portion column 3, line 58 through column 4, line 14 confirms this. In column 4, lines 1-2, it is disclosed that the sensor (ultrasonic transmitter/receiver) is definitively located within a recess (see line 9) of the electrode holder 6, that is, far away from the electrode cap 16 or the shaft 8.

AAPA (Fig. 1) shows a connecting element comprising a sensor. The connecting element is mounted between an electrode cap and the electrode itself and therefore, is not used for connecting an electrode with an electrode arm. The transmitted ultrasound waves should be maintained as short as possible here (see page 19, first paragraph).

Because neither Vogt nor the AAPA discloses all of the features of independent claim 1, the rejection under Section 102 must be withdrawn. For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ 2d, 1481, 1490 (Fed. Cir. 1997).

Furthermore, the solution of the present invention cannot be derived from the remaining figures of the AAPA. The Applicants respectfully submit that the analysis of the AAPA constitutes impermissible hindsight, which takes into consideration the present invention itself.

With regard to the rejections under Section 103, the Waschkies reference discloses a solution in which the sensors are located directly on the outside wall of the electrodes without using a support, holding device, or connecting element that comprises the sensors (column 11, lines 52-63). Because neither Vogt nor the AAPA discloses all of the features of the present invention, as argued above, Waschkies does not teach the missing elements that are required to arrive at the present invention in combination with the other references.

Specifically, Waschkies does not provide any suggestion that instructs the skilled practitioner to use the connecting element of the AAPA for fixing the electrode with an electrode arm. On the contrary, the AAPA teaches the practitioner away from this solution, since the focus is on a short transmission path (page 19, first paragraph). No teaching can be found for inserting the sensor into the shaft disclosed by Vogt. These features also cannot be derived from Waschkies.

Therefore, the rejections under Section 103 also must be withdrawn. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ***ACS Hosp. Sys., Inc. v. Montefiore Hosp.***, 221 USPQ 929, 932, 933 (Fed. Cir. 1984). Here, the cited art fails to provide any such suggestion or incentive.

For the reasons set forth above, the Applicants respectfully submit that claims 1-21 are patentable over the cited art. The Applicants further request

withdrawal of the rejections under 35 U.S.C. 102 and 103 and reconsideration of the claims as herein amended.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



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